

Serial No.: 09/480,011
Art Unit: 2623

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 16, 2006. Through this response, claims 13, 20, 25, and 28-35 have been amended. Claims 20 and 25 have been amended solely to replace "bandwith" with "bandwidth." Reconsideration and allowance of the application and pending claims 13-35 are respectfully requested.

RECEIVED
CENTRAL FAX CENTER

AUG 16 2006

I. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 20, 21, 23-26, 28-30 and 32-35 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Matthews, III* ("*Matthews*," U.S. Pat. No. 5,874,985) in view of *Hendricks et al.* ("*Hendricks*," U.S. Pat. No. 5,600,573). Claim 31 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Matthews* and *Hendricks*, as applied to claim 28 above, and further in view of *Tanaka* ("*Tanaka*," U.S. Pub. No. 2003/0115600 A1). Claims 13-19 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Matthews* in view of *Hendricks* and *Tanaka*. Claims 22 and 27 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Matthews* and *Hendricks* as applied to claim 20 above, and further in view of *Jennings* ("*Jennings*," U.S. Pat. No. 5,781,186). Applicants respectfully traverse these rejections.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a

Serial No.: 09/480,011

Art Unit: 2623

prima facie case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Serial No.: 09/480,011
Art Unit: 2623

Independent Claim 20

Claim 20 recites (with emphasis added):

20. A system for providing customizable multimedia messages over a television system to a communications terminal for presentation to a user, comprising:

at least one application server that generates at least one message configuration, each application server being capable of providing interactive services that enable a communications terminal to communicate over the television system;

a multimedia messaging server that receives at least one message configuration from the at least one application server and associates message content for presentation to a user according to the at least one message configuration, and generates a request according to the at least one message configuration, the request including the message content and a message configuration expression for delivery over a television system to the communications terminal associated with the user, *wherein the at least one application server and the multimedia messaging server are located in the headend*, the multimedia messaging server being capable of managing the delivery of the request over the television system to the communications terminal, thereby conserving system bandwidth; and

a multimedia messaging client that receives the request and associates the message content and the message configuration for presentation of the message content according to the message configuration.

Applicants respectfully submit that *Matthews* in view of *Hendricks* fails to disclose, teach, or suggest at least the above emphasized claim features. As admitted in the Office Action (page 3), *Matthews* fails to disclose "wherein the at least one application server and the multimedia messaging server are located in the headend." Applicants respectfully submit that *Hendricks* fails to remedy this deficiency. The Office Action (page 3) alleges that the operations center 202 in Figure 2 of *Hendricks* is a *headend*, and further alleges that the computer assisted packaging 316 utilized by the operations center 202 is an application server. Applicants respectfully disagree. The operations center 202 is clearly distinguished throughout the specification of *Hendricks* from the headend 208. Further, even assuming

Serial No.: 09/480,011
Art Unit: 2623

the computer assisted packaging 316 can be equated to an application server, it is clear that the computer assisted packaging 316 is located in the operations center 202, not in the headend 208. Thus, Applicants respectfully submit that a prima facie case of obviousness has not been established, and accordingly, the rejection should be withdrawn.

Because independent claim 20 is allowable over *Matthews* in view of *Hendricks*, dependent claims 21-24 are allowable as a matter of law for at least the reason that the dependent claims 21-24 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Additionally, with regard to the rejection to claims 22 and 27, since independent claim 20 is allowable over *Matthews* in view of *Hendricks*, and that the deficiencies of *Matthews* in view of *Hendricks* are not remedied by *Jennings*, Applicants respectfully submit that dependent claims 22 and 27 are allowable for at least the reasons that dependent claims 22 and 27 incorporates the features of allowable claim 20.

Serial No.: 09/480,011
Art Unit: 2623

Independent Claim 25

Claim 25 recites (with emphasis added):

25. A system for delivery of multimedia messages, comprising:
a multimedia messaging server; and
at least one application server in which each server generates message content and a database of predefined message configurations, each application server being capable of providing interactive services that enable a communications terminal to communicate over the television system,
wherein each application server delivers the message content and at least one of the database of predefined message configurations to the multimedia messaging server, which in response thereto, generates a request that comprises the message content and a message configuration expression for delivery over a television system to a communications terminal associated with the user, *wherein the at least one application server and the multimedia messaging server are located in the headend*, the multimedia messaging server being capable of managing the delivery of the request over the television system to the communications terminal, thereby conserving system bandwidth.

For similar reasons presented above in association with claim 20, Applicants respectfully submit that *Matthews* in view of *Hendricks* fails to disclose, teach, or suggest at least the above emphasized claim features. Accordingly, Applicants respectfully request that the rejection to independent claim 25 be withdrawn.

Because independent claim 25 is allowable over *Matthews* in view of *Hendricks*, dependent claims 26-27 are allowable as a matter of law.

Serial No.: 09/480,011
Art Unit: 2623

Independent Claim 28

Claim 28 recites (with emphasis added):

28. A method for providing customizable multimedia messages over a television system to a communications terminal for presentation to a user, comprising:
creating a first message configuration by a first application server and a second message configuration by a second application server, the first message configuration different from the second message configuration, each application server being capable of providing interactive services that enable a communications terminal to communicate over the television system;
sending the first message configuration and the second message configuration respectively from the first application server and the second application server to a multimedia messaging server;
receiving the first message configuration and the second message configuration at the multimedia messaging server;
creating application independent message activation requests for presenting a first message content and a second message content to messaging client software of the communications terminal associated to the user according to the first message configuration and the second message configuration, respectively, the message activation requests being delivered over a television system for processing by the messaging client software at the communications terminal associated with the user;
managing the delivery of the requests over the television system to the communications terminal, thereby conserving system bandwidth; and
sending the message activation requests from the multimedia messaging server to the communications terminal over the television system.

Applicants respectfully submit that the rejection to claim 28 has been rendered moot in view of the amendments to the claim. In view of these amendments, Applicants respectfully submit that claim 28 is allowable over *Matthews* in view of *Hendricks* for at least the reason that *Matthews* in view of *Hendricks* fails to disclose, teach, or suggest at least the above emphasized claim features.

Because independent claim 28 is allowable over *Matthews* in view of *Hendricks*, dependent claims 29-35 are allowable as a matter of law.

Serial No.: 09/480,011
Art Unit: 2623

Additionally, with regard to the rejection of dependent claim 31 using *Matthews* in view of *Hendricks* and further in view of *Tanaka*, Applicants respectfully submit that the rejection has been rendered moot in view of the amendments to independent claim 28. Further, since independent claim 28 is allowable over *Matthews* in view of *Hendricks*, and that the deficiencies of *Matthews* in view of *Hendricks* are not remedied by *Tanaka*, Applicants respectfully submit that dependent claim 31 is allowable for at least the reasons that dependent claim 31 incorporates the features of allowable claim 28.

Serial No.: 09/480,011
Art Unit: 2623

Independent Claim 13

Claim 13 recites (with emphasis added):

13. A method for receiving customizable multimedia messages over a television system at a communications terminal for presentation to a user, comprising:

- creating a plurality of message configurations corresponding to different messaging services having different predefined formats by a plurality of application servers*, each application server being capable of providing interactive services that enable the communications terminal to communicate over the television system;
- sending the plurality of message configurations from the plurality of application servers to a multimedia messaging server;
- receiving the plurality of message configurations at the multimedia messaging server;
- configuring at the multimedia messaging server a plurality of different message requests with respective message content expressions and respective message configuration expressions, the plurality of different message requests being associated with the received plurality of message configurations, the multimedia messaging server being capable of managing the delivery of the requests over the television system to the communications terminal, thereby conserving system bandwidth;
- configuring a first type of expression to correspond to including in a message request a location reference to retrieve message information from a location remote from a communication terminal;*
- configuring a second type of expression to correspond to including in a message request message information;
- receiving at the communications terminal from the multimedia messaging server a first message request including a first message content expression and a first message configuration expression;
- responsive to receiving the first message request, presenting a first message to a user according to the first message content expression and the first message configuration expression;
- receiving at the communications terminal from the multimedia messaging server a second message request including a second message content expression and a second message configuration expression; and
- responsive to receiving the second message request, presenting a second message to a user according to the second message content expression and the second message configuration expression, wherein the second message request includes at least one type of expression different than the type of expressions in the first message request.

Serial No.: 09/480,011
Art Unit: 2623

Applicants respectfully submit that the rejection to claim 13 has been rendered moot in view of the amendments to the claim. In view of these amendments, Applicants respectfully submit that claim 13 is allowable over *Matthews* in view of *Hendricks* and *Tanaka* for at least the reason that *Matthews* in view of *Hendricks* and *Tanaka* fails to disclose, teach, or suggest at least the above emphasized claim features.

Because independent claim 13 is allowable over *Matthews* in view of *Hendricks* and *Tanaka*, dependent claims 14-19 are allowable as a matter of law.

In addition to the above described defects of the rejection, Applicants respectfully assert that the proposed combinations are not obvious, and in fact, unreasonable in view of the disparity of systems and approaches. For instance, *Matthews* appears to focus on "message" delivery (see title), whereas *Hendricks* appears to focus on organizing and packaging cable television programming. Indeed, there are no messaging servers or application servers with messaging functionality even mentioned in *Hendricks*. Thus, Applicants respectfully submit that the proposed combination of *Matthews* and *Hendricks* is not obvious, and hence respectfully request that the rejection be withdrawn.

Further, the proposed addition of *Tanaka* to *Matthews* and *Hendricks* is also not obvious, and in fact, unreasonable in view of the disparity of systems and approaches. For instance, the Office Action alleges on page 12 "it would have been obvious to one of ordinary skill in the art at the time of the invention by applicant to modify *Matthews*' system to include retrieving the message configuration from a remote location, as taught by *Tanaka*, for the advantage of allowing the use of a receiver without an large storage means in the current message transmission system." However, *Matthews* teaches just the opposite of remote storage, as shown in col. 5, lines 60-67 (*Matthews*) and reproduced below:

Serial No.: 09/480,011
Art Unit: 2623

Preferably, the viewer station identifier is stored within memory 68 of interactive station controller 20 and at central control node 12, and the message image formats representing both message blocks 100 and 102 are stored in memory 68. The message image formats stored within memory 68 of interactive station controller 20 allow messages to be transmitted to the selected viewer stations 16 with minimal message image format information.

Thus, Applicants respectfully submit that the proposed combination of *Matthews* and *Hendricks* and *Tanaka* is not obvious, and hence respectfully request that the rejection be withdrawn.

In summary, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

II. Official Notice

The Office Action takes Official Notice with regard to claim 19, and in particular, states the following on page 15 of the Office Action:

The Examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize a default in the absence of a specific signal, whereby the system is to assume the default unless told otherwise, for the typical benefit of allowing the receiver to quickly process incoming messages by using the most common default setting in the absence of any other corresponding command.

Applicants traverse this rejection as being in error, and in particular, request clarification in the next Office Action. Claim 19 includes the feature of "configuring a third type of expression to correspond to a default message configuration according to the absence of a message configuration expression in a message request," not utilizing "a default in the

Serial No.: 09/480,011
Art Unit: 2623

absence of a specific signal.” Thus, the features of claim 19 have not been adequately addressed by the Official Notice.

In addition, MPEP Section 2144.03 allows the taking of Official Notice in limited circumstances, when “it is appropriate for an examiner to take official notice of facts not in the record.” However, the Office Action alleges on page 19 that “the feature of utilizing a default in the absence of a specific signal is disclosed by Hendricks (5,559,549) (of record) (see column 13, lines 51-61).” This is the same language as used in the Official Notice pertaining to claim 19. In other words, the Office Action appears to be taking contrary positions, stating on one hand that features not found in claim 19 are “notoriously well known,” and on the other hand stating that such features are allegedly found in *Hendricks*. This confuses the issue of patentability and the basis of the rejection as it pertains to claim 19. Thus, Applicants respectfully traverse this finding of well-known art and Official Notice at least on the bases that the traversal does not address the explicit limitations of the claim and because the taking of Official Notice, in light of the allegation with regard to the alleged disclosure in *Hendricks* (the admission of which is neither expressed nor implied by Applicants), is contrary to the requirements of MPEP Section 2144.03.

In addition, in the Response to Arguments section of the Office Action, pages 17-18, the Office Action discusses the alleged inadequacy of Applicants’ prior traversals of Official Notice, and refers to Section 2144.03 of the MPEP. Applicants have reproduced that section of the MPEP pertaining to Applicant challenges below for reference (emphasis added):

Serial No.: 09/480,011

Art Unit: 2623

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

In Section 7(a), page 17 of the Office Action, the following is alleged:

In this case, applicant has not specifically requested any evidentiary support with respect to references or specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. Applicant's general statement that none of the Official Notices include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions does not point out any specific error or reason as to why any of the facts were not common knowledge or well-known in the art, and thus does not constitute a proper traversal. A blanket traversal to any and all Official Notices does not specifically point out any supposed errors.

Applicants respectfully disagree. Applicants have included the challenge made in the last response (dated February 21, 2006) below:

Serial No.: 09/480,011

Art Unit: 2623

Applicants respectfully traverse all Office Notices and well-known allegations made in the Office Action and submit such should not be considered well-known because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions. Furthermore, the findings are too complex and detailed to be supportable as well-known in the combinations claimed. The Office Action has taken Official Notice that "it was notoriously well known in the art at the time of invention by applicant to transmit a location reference to identify a location from which to retrieve message content, such as utilized by the well known ATVEF standard, for the typical benefit of allowing the receiver to easily locate and display content from sources other than the broadcast provider." (Page 4, paragraph 5 of the Office Action). The Office Action further stated that "it was notoriously well known in the art at the time of the invention by applicant to transmit updated information to a receiver at boot-up or initialization for the typical benefits of ensuring that a recently activated system has the most current information." (Page 5, paragraph 3, page 15, paragraph 4 of the Office Action). The Office Action further stated that "it was notoriously well known in the art at the time of invention by applicant to utilize servers to receive and process incoming signals, such as in a cable headend, for the typical benefit of receiving and processing transmitted signals through well known and commonly utilized servers." (Page 8, paragraph 2 of the Office Action). The Office Action further stated that "it was notoriously well known in the art at the time of invention by applicant to utilize servers to receive and process incoming signals, such as in a cable headend, for the typical benefit of receiving and processing transmitted signals through well known and commonly utilized servers." (Page 10, paragraph 3 of the Office Action). The Office Action further stated that "it was notoriously well known in the art at the time of invention by applicant to utilize a default in the absence of a specific signal, whereby the system is to assume the default unless told otherwise, for the typical benefit of allowing the receiver to quickly process incoming messages by using the most common default setting in the absence of any other corresponding command." (Page 16, paragraph 4 of the Office Action). The Office Action further stated that "it was notoriously well known in the art at the time of invention by applicant to identify a location reference to identify a location from which to retrieve message content, utilize a default in the absence of a specific signal, whereby the system is to assume the default unless told otherwise and utilize servers to receive and process incoming signals." (Page 27, paragraph 2 of the Office Action).

According to MPEP 2144.03, "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." MPEP 2144.03 also states that "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Office Action must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." Accordingly, Applicants respectfully traverse the above conclusions and submit that the subject matter noted above should not be considered well known because

Serial No.: 09/480,011
Art Unit: 2623

the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions. Accordingly, Applicants submit that it has not been shown that the material asserted to be well-known is capable of instant and unquestionable demonstration as being well-known.

As is clear from above, Applicants indeed have specifically pointed out the supposed errors in the examiner's action, including stating why the noticed fact is not considered to be common knowledge or well-known in the art. For instance, each fact or set of facts corresponding to claim features (*i.e.*, each error in the examiner's action) to which Official Notice was taken in the Office Action mailed on 10/20/2005 are specifically pointed out in the response as noted above and as required by MPEP 2144.03.

Further, the response points out, twice, why the noticed facts are not considered to be common or well-known. The response states one reason is "because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions," and the other reason is because "the findings are too complex and detailed to be supportable as well-known in the combinations claimed." Such reasons are indeed reasons why the facts noticed are not well-known, since had the facts been well-known, support using specific factual findings predicated on sound technical and scientific reasoning may have proffered. Applicants respectfully submit that such support for the facts noticed has not been provided.

The allegation that the challenge was a "blanket traversal" appears to erroneously presume that the reasons were different. That is, there is no requirement in Section 2144.03 of the MPEP that reasons presented in support of the challenge be different, but instead, simply (at best) that at least one reason be submitted, which was done. In fact,

Serial No.: 09/480,011

Art Unit: 2623

the reasons presented were the same for each error. Additionally, Applicants point out that a "blanket traversal" is distinguishable from a "common reason," since a blanket traversal would not be supported by any additional reasoning, common or different.

Additionally, because the traversal was adequate, section 2144.03 of the MPEP requires that documentary evidence be provided ("If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained."). Applicants respectfully submit that the traversal was adequate as explained above, and further submit that the conclusion of admitted prior art is not only erroneous, but contrary to Applicants' position. Accordingly, Applicants respectfully request that the conclusion of admitted prior art be withdrawn from the record, and further request that the next Office Action provide documentary evidence to support all Official Notices herein and previously traversed, or alternatively, withdraw the rejections.

The Office Action further asserts the following (page 18) with regard to alleged admission of prior art:

Furthermore, it is noted that regards the facts of: transmitting a location reference to identify a location from which to retrieve message content, utilizing servers to receive and process incoming signals and utilizing a default in the absence of a specific signal, applicant's traversal is untimely as these facts have all previously been indicated as admitted prior art as applicant did not properly traverse the Official Notice when appropriate.

Applicants respectfully disagree. Applicants refer to the September 19, 2005 response, pages 23-24, which adequately traverse in timely manner the Official Notices by specifying each error and by providing at least one reason, valid for each error, why the facts noticed are not considered to be well-known or commonly known.

Serial No.: 09/480,011

Art Unit: 2623

Even if the Examiner does not agree with the Applicants' reasoning as to why the subject matter is not considered to be well-known, Applicants respectfully submit that this is a separate inquiry as to whether Applicants did, in fact, provide at least one reason for traversing the taking of Official Notice, and Applicants clearly did at least that, and thus, no admission. Accordingly, Applicants respectfully request that the conclusion of admitted prior art be withdrawn from the record, and further request that the next Office Action provide documentary evidence to support all Official Notices herein and previously traversed, or alternatively, withdraw the rejections.

Serial No.: 09/480,011
Art Unit: 2623

RECEIVED
CENTRAL FAX CENTER

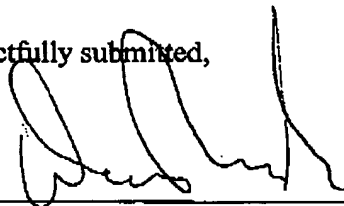
AUG 16 2006

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David Rodack
Registration No. 47,034

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.